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APR 10 2008

In re Reissue Application of
Gary P. Kasner et al.
Application No. 09/862,905
Filed: May 21, 2001
Attorney Docket No. 1915.14US03

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OFFICE OF PETITIONS

ON PETITION

This is a decision on the petition under 37 CFR 1.183 filed March 18, 2008, requesting waiver of 37 CFR §§ 1.67 and 1.172¹ which require that the supplemental reissue declaration of March 18, 2008 have been executed by all of the inventors.

The petition is **GRANTED**.

BACKGROUND

1. U.S. Patent No. 5,094,041 issued to Kasner and Stoll on March 10, 1992.
2. A broadening reissue application was filed for the '041 patent on March 10, 1994, and it was assigned application number 08/209,559. The instant application, filed May 21 2001, is a continuation of 08/209,559.
3. During the prosecution of the parent application, the Office required a supplemental reissue declaration directed to errors in the original patent which had been corrected in the application after the signing of the original reissue declaration.
4. On November 14, 2007, a final Office action was mailed in the instant application, noting that the reissue declaration signed by joint inventors Kasner, Stoll and Morris was defective, as follows:
 - 1) The reissue oath/declaration filed March 13, 2007 with this application is defective because it fails to appropriately state that applicant believes the original

¹Once an application has received a fully executed oath or declaration and been placed on the files for examination, the provisions of 37 CFR 1.47 no longer apply. Rather, the remedy for treating an inventor's refusal to also sign a supplemental oath or declaration is waiver of 37 CFR 1.67. See MPEP 603.

patent to be either wholly or partly inoperative, or invalid by reason of a defective specification or drawing, or by reason of the patentee claiming either more or less than the patentee had the right to claim in the patent. See M.P.E.P. 1414(I).

2) The reissue oath/declaration filed March 13, 2007 is defective because it fails to appropriately identify at least one error which is relied upon to support the reissue application. See 37 CFR 1.175(a)(1) and MPEP § 1414.

The reissue oath/declaration filed March 13, 2007 does not clearly state an error within the original Patent. Language directed to "e.g., a claim in non-Jepson format reciting, in part, a recessed area in a top panel of a roof ventilator, the recessed area being non-linear in cross section, which is broader in scope than, e.g., claim 9, which recites a recessed area having a pair of side walls traversing a generally oval-shaped path", does not clearly establish the error upon which the instant reissue application is based.

MPEP. 1414(11)(C):

Any error in the claims must be identified by reference to the specific claim(s) and the specific claim language wherein lies the error. A statement of " ... failure to include a claim directed to ..." and then presenting a newly added claim, would not be considered a sufficient "error" statement since applicant has not pointed out what the other claims lacked that the newly added claim has, or vice versa. Such a statement would be no better than saying in the reissue oath or declaration that "this application is being filed to correct errors in the patent which may be noted from the change made by adding new claim 10." In both cases, the error has not been identified.

3) The reissue oath/declaration filed March 13, 2007 is defective because it fails to identify all amendment by which the claims of the patent have been changed. See 37 CFR 1.63(b)(2) and MPEP § 1414.

4) The reissue oath/declaration filed with this application is defective (see 37 CFR 1.175 and MPEP § 1414) because of the following: The reissue declaration filed March 13, 2007 fails to state that the person making the oath or declaration acknowledges the duty to disclose to the Office all information known to the person to be material to patentability as defined in § 1.56.

5. On March 18, 2008, a supplemental declaration was filed in response to the November 14, 2007 final Office action. The supplemental declaration is signed by joint inventors Stoll and Morrison and provides a showing that joint inventor Kasner has refused to sign the Reissue Declaration despite efforts to have him do so.

DECISION

37 CFR 1.172 requires that a reissue declaration or oath be made (and signed) by the inventors, except as otherwise provided (37 CFR §§ 1.42, 1.43, 1.47), where the scope of the claims of the original patent is being enlarged. In addition, 37 CFR 1.175(b)(1), requires that:

“For any error corrected, which is not covered by the oath or declaration submitted under paragraph (a) of this section, applicant must submit a **supplemental oath or declaration** stating that every such error arose without any deceptive intention on the part of the applicant.” [Emphasis added]

37 CFR 1.175(b)(1), taken in conjunction with 37 CFR 1.172, requires that a supplemental oath or declaration be signed by the inventor(s). This is because all oaths or declarations necessary to fulfill the rule requirements in a reissue application are taken together collectively as a single oath or declaration. Thus, each oath and/or declaration must bear the appropriate signatures of the inventors.

In the present instance, the petition provides a sufficient showing that, while efforts have been employed to have the supplemental declaration signed by all of the inventors, those efforts have been unsuccessful. 37 CFR 1.183 permits, in an extraordinary situation, waiver of a rule which is not a requirement of the statute, where justice requires such waiver, and applicant has requested, via the present petition, a waiver of the requirement that the 37 CFR 1.175(b)(1) supplemental declaration be signed by the inventors.

The instant petition and supporting declaration of William Larry Alexander provide an appropriate and sufficient showing that despite efforts to have joint inventor Kasner sign the supplemental declaration, joint inventor Kasner refuses to do so. Accordingly, the rules are hereby waived to the extent that the “Supplemental Reissue Application Declaration” submitted with the present petition will be accepted as though it was signed by all of the inventors as required by 37 CFR 1.175(b)(1) taken in conjunction with § 1.172. See *In re Hayes*, 53 USPQ2d 1222 (Comm’r Pat. 1999).

CONCLUSION

1. The petition under 37 CFR 1.183 is granted to waive the rules.
2. The provisions of 37 CFR 1.175(b)(1), and 37 CFR 1.172 are hereby waived to the extent that the March 18, 2008, "Supplemental Reissue Application Declaration" submitted with the present petition will be accepted as though it was signed by all of the inventors.
3. The present application is being forwarded to Technology Center 3637 for further prosecution.
4. Any questions regarding this decision should be directed to Senior Petitions Attorney Patricia Faison-Ball at (571) 272-3212.



Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration

March 8, 2008

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